

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SPENCER KOVNER

Appeal No. 1998-0233
Application 08/469,065

ON BRIEF

Before McCANDLISH, ***Senior Administrative Patent Judge***, and
PATE and BAHR, ***Administrative Patent Judges***.

PATE, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
19 through 28. Claims 1 through 18 and 29 through 36 were
non-

elected claims. They stand withdrawn from consideration.

The claimed invention is directed to a business card storage and retrieval system and the method for storing and retrieving business cards. The apparatus consists of a plurality of business card holders of rectangular sheet form having a depressed area thereon of generally the size of a rectangular business card. Holes are provided in the card holder for mounting the corners of the business card.

The invention can be further understood with reference to the appealed claims appended to appellant's brief.¹

The references of record relied upon as evidence of obviousness are:

Hanson	1,867,218	July 12, 1932
McCabe	2,637,325	May 5, 1953
Goldman	3,496,665	Feb. 24, 1970
Finger	4,949,484	Aug. 21, 1990
Ristuccia	D-310,098	Aug. 21, 1990

¹ We note in claim 19 the recitation that card holders are arranged in a row, side by side. In our view, the cards are arranged in a row, front to back.

THE REJECTIONS

The following rejections are before us on appeal.

Claims 19 through 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. It is the view of the

examiner that claim 19 is unclear as to whether the claim positively recites or claims a business card in combination with the storage system.

Claims 19 through 21, 24, 25 and 26 stand rejected under 35 U.S.C. § 103 as unpatentable over Finger in view of Ristuccia and Goldman. According to the examiner, Finger discloses a mounting device including guide rails for mounting informational cards in a storage system. The examiner finds that Ristuccia discloses a business card holder comprising a thin sheet and a rectangular recessed area. The examiner states that Goldman shows the idea of placing holes in each corner of a recessed area for allowing cards to be secured to

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the recessed area. In view of these teachings, the examiner has concluded that it would have been obvious to modify Finger by placing a recessed area and holes in each corner of the recessed area so that cards could be attached to the card holder for more secure storage and retrieval.

Claims 22 and 27 stand rejected under 35 U.S.C. § 103 as unpatentable over Finger in view of Ristuccia and Goldman, and further in view of McCabe. According to the examiner, McCabe shows the idea of placing slits extending outwardly from each of the holes used to secure the corner of the business cards.

Therefore, the examiner concludes that it would have been obvious to use the teaching of McCabe to modify the holes that would retain the business cards to the business card holders.

Claims 19 through 21, 23-26 and 28 stand rejected under 35 U.S.C. § 103 as unpatentable over Hanson in view of Ristuccia and Goldman. Here again, Hanson shows another mounting device for mounting the business card holders. Therefore, the examiner concludes that it would have been

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obvious to mount the business card holders of Ristuccia in a holder such as the Hanson holder.

Claims 22 and 27 are rejected under 35 U.S.C. § 103 as unpatentable over Hanson in view of Ristuccia, Goldman, and further in view of McCabe. Here again, McCabe teaches using slits that extend outwardly from the holes. The examiner is of the view that it would have been obvious to mount the credit card holders of Ristuccia in the mounting system of Hanson and to provide the credit card holder with holes and slits as taught by McCabe and Goldman.

As noted by the examiner, claims 19, 20, 24 and 25 have been separately argued by appellant in the brief. Therefore, the examiner concludes that claims 21 through 23 will stand or fall

with claim 19 and claims 26 through 28 will stand or fall with claim 24.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the determination that the prior art establishes a ***prima facie*** case of obviousness with respect to claims 19 through 23, 24 and 26 through 28. The rejections of these claims will be affirmed. We have further determined that the applied prior art does not establish the ***prima facie*** obviousness of claim 25. Therefore, the rejection of claim 25 is reversed. Our reasons follow.

It is our finding that both Finger and Hanson show storage containers for the use of and retrieval of information carrying cards. In Finger, Figure 13 shows a cabinet which holds card retaining tray means 80 with guide rail 92 mounted on the bottom thereof. Hanson discloses a file drawer with separate information containing cards 47 held by guide rail pin 44. Ristuccia is a design patent showing a business card holder made of a generally rectangular sheet with outside dimensions

greater than a business card. The rectangular area on the sheet can be

embossed therein as shown in Figure 13. The embossed area is generally the size of a business card to be attached thereto. The business card holders of Ristuccia show what appear to be several mechanisms for attaching the card to the business card holder. Figure 7 appears to show holes and slots while Figures 1 and 19 appear to show other holding means. Finally, the examiner has cited either McCabe or Goldman to teach the concept of corner holes to hold one sheet to another sheet where the sheet is a numeral such as displayed by Goldman, or a photograph or a frame in an album sheet as disclosed by McCabe.

In our view, the combined teachings of these references, whether taken as Finger in view of Ristuccia and Goldman, Hanson in view of Ristuccia and Goldman, Finger in view of Ristuccia, Goldman and McCabe, or Hanson in view of Ristuccia, Goldman and McCabe, would have rendered the subject matter of claims 19 through 23, 24 and 26 through 28 ***prima***

facie obvious to one of ordinary skill. Ristuccia shows a business card holder that is clearly manufactured to fit in one of the holding devices disclosed by Finger or Hanson. Furthermore, the business card holder of Ristuccia clearly has a rectangular dimension which is placed inward parallel to the surface of the business sheet by an amount approximately equal to the thickness of the business card.

Finally, Ristuccia suggests several different arrangements to attach the business card to his business card holder. One arrangement in Figure 7 even discloses holes and a slot. Both McCabe and Goldman also show the holes to attach a sheet of material to another sheet. In fact, Goldman shows the hole in a corner of a recess in the sheet for attaching another sheet thereto. In view of these teachings, it would have been **prima facie** obvious to attach business cards to the Ristuccia business card holder using the holes and slots taught by either Goldman or McCabe and to place these card holders into a mounting device as shown by Finger or Hanson. With respect

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to argued claim 20, we note, as stated by the examiner, that claim 20 is a product-by-process limitation that does not serve to distinguish the subject matter claimed from the business card holder disclosed in Ristuccia.

However, with respect to claim 25, the examiner has not provided any evidence that it would have been obvious to manufacture the business card holders as illustrated by Ristuccia from a continuous web by die cutting the web and practicing the method claimed by appellant. Certainly, the appellant has stated in his specification that the die cut apparatus is known in the art. But the examiner has not provided any evidence that it would have been obvious to make the card holders from such an apparatus. Reliance on appellant's specification for this suggestion or motivation is not proper. Therefore, the rejection of claim 25 is reversed.

With respect to the declaration submitted by the appellant, a copy of which is attached to the brief, the declaration merely states that appellant was only aware of

three attachment methods for affixing business cards to business card holders. That the attachment method appellant claims was not among the commercial attachment methods discovered by appellant, runs merely to the novelty of the claimed apparatus and method and does not pertain to the obviousness issue presented by the rejections on appeal. In no way can the declaration provide any evidence to rebut the *prima facie* case of obviousness established by the examiner.

With respect to the 35 U.S.C. § 112 rejection of claims 19 through 23, the examiner states that it cannot be discerned whether the card storage and retrieval system therein claimed claims the combination of the system with a business card or without. In our view, the reference to the business card in the body of the claim is merely an intended use or background environment with respect to the system being claimed. We do not find that such a recitation obscures the metes and bounds of the claimed invention. Therefore, the rejection of claims 19 through 23 under 35 U.S.C. 112 is reversed.

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SUMMARY

The rejection of claims 19 through 23 under 35 U.S.C. § 112, second paragraph, is reversed. The rejections of claims 19 through 24 and 26 through 28 under 35 U.S.C. § 103 are affirmed. The rejection of claim 25 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

	HARRISON E. McCANDLISH)	
	Senior Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	WILLIAM F. PATE, III)	APPEALS
AND)	
	Administrative Patent Judge)	
INTERFERENCES)	
)	
)	
	JENNIFER D. BAHR)	

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Administrative Patent Judge)
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